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**JAN 09 2009**

In re Application of :  
Jeffrey Johnson :  
Filing Date: March 19, 2004 :  
Application No.: 10/804,127 : DECISION  
Attorney Docket No.: 10346.70000US01 :  
For: SYSTEM FOR ACQUIRING AND :  
MANAGING DIGITAL RECORDS :

This above-identified application has been forwarded to the undersigned for review of the propriety of an interview conducted on December 15, 2008.

The content of the interview and any agreement that may have been reached is void and the Office hereby treats the interview as a nullity.

**BACKGROUND**

On December 15, 2008, a paper granting permission for David Gesner to participate in a telephonic interview and granting him permission to communicate with the Examiner, which was signed by Steven Henry (Reg. No. 27,900) was received in the Office. David Gesner is not an applicant, nor is he registered to practice before the U.S. Patent & Trademark Office.

On December 15, 2008, a telephonic interview was conducted with Examiner Jacob B  tit, Supervisory Patent Examiner Tony Mahmoudi, David Gesner and Steven Henry.

David Gesner organized the interview and conducted the interview with the Examiner and the Supervisory Patent Examiner. David Gesner provided a summary of the invention and arguments for patentability of the claims. Steven Henry also participated in the interview.

On December 17, 2008, a response was received by the Office wherein on page 6 of the response, Steven Henry acknowledged the telephonic interview of December 15, 2008, in which he and David Gesner participated.

## DECISION

37 CFR § 10.47 provides:

- (a) A practitioner shall not aid a non-practitioner in the unauthorized practice of law before the Office.
- (b) A practitioner shall not aid a suspended or excluded practitioner in the practice of law before the Office.
- (c) A practitioner shall not aid a non-lawyer in the unauthorized practice of law.

37 CFR § 10.57 provides:

- (a) "Confidence" refers to information protected by the attorney-client or agent-client privilege under applicable law. "Secret" refers to other information gained in the professional relationship that the client has requested be held inviolate or the disclosure of which would be embarrassing or would be likely to be detrimental to the client.
- (b) Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly:
  - (1) Reveal a confidence or secret of a client.
  - (2) Use a confidence or secret of a client to the dis-advantage of the client.
  - (3) Use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client consents after full disclosure.
- (c) A practitioner may reveal:
  - (1) Confidences or secrets with the consent of the client affected but only after a full disclosure to the client.
  - (2) Confidences or secrets when permitted under Disciplinary Rules or required by law or court order.
  - (3) The intention of a client to commit a crime and the information necessary to prevent the crime.
  - (4) Confidences or secrets necessary to establish or collect the practitioner's fee or to defend the practitioner or the practitioner's employees or associates against an accusation of wrongful conduct.
- (d) A practitioner shall exercise reasonable care to prevent the practitioner's employees, associates, and others whose services are utilized by the practitioner from disclosing or using confidences or secrets of a client, except that a practitioner may reveal the information allowed by paragraph (c) of this section through an employee.

The MPEP § 713.05 provides:

Office employees are forbidden to hold either oral or written communication with an unregistered or a suspended or excluded attorney or agent regarding an application unless it is one in which said attorney or agent is the applicant. See MPEP § 105. . . . Note that pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure. Furthermore, a practitioner can not authorize a nonpractitioner to conduct interviews since this would be contrary to 37 CFR 10.47.


A search of the Office records reveals that David Gesner is not a registered practitioner nor is he an applicant of the above-identified application. Steven Henry, a registered practitioner is

without authority to authorize David Gesner, a nonpractitioner, to conduct an interview as a practitioner can not authorize a nonpractitioner to conduct an interview.

### CONCLUSION

The Office considers the interview of December 15, 2008 a nullity as it was conducted by an improper person. Any agreement that may have been reached at the interview is considered as void or a nullity.<sup>1</sup>

Telephone inquiries concerning this decision should be directed to Mark Polutta at (571) 272-7709.



Robert A. Clarke

Director

Office of Patent Legal Administration

Office of the Deputy Commissioner

for Patent Examination Policy

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<sup>1</sup> See CHANDRIS v. YANAKAKIS, 668 So.2d 180 (Fla.1995) (out of state attorney engages in unauthorized practice of law where that attorney enters into contingent fee agreement in state (Florida) thereby rendering that fee agreement void); Duncan v. Gordon, 476 So.2d 896 (La.App. 2 Cir. 1985) (any contract by a non-lawyer who renders services in violation of state law is for an unlawful cause, and consequently, the contract is against public policy and absolutely null).